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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,655	08/04/2000	OSAMU SAKANAKA	20001081A	8304

7590 07/14/2005

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EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/601,655	SAKANAKA ET AL.
	Examiner	Art Unit
	Binta M. Robinson	1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,9,10,14,19-21 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 32 is/are withdrawn from consideration.
- 5) Claim(s) 9 and 10 is/are allowed.
- 6) Claim(s) 1,3,14,19 and 23-26, 28 is/are rejected.
- 7) Claim(s) 20,21 and 27 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/25/2005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**Detailed Action**

The whole scope of claims 1, 3, 9, 10, 14, 19, 20, 21, 2324, 25, 26-29, 31 have been examined. Claims 30, 32 are withdrawn from consideration. In light of applicant's remarks, the 112, first rejection of claim 32 is withdrawn because claim 32 is withdrawn from consideration, the 112, second paragraph rejections of claims 1, 3, 19, 20, 21, 23, 24, 25, 26, 29, and 31 are withdrawn in light of applicant's remarks and amendment.

**(new rejections)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 23, 24, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueki et. al. et. al. (, Vol. 50, 7). See Reference U. Ueki et. al. discloses the instant compound, UK-3A. At page 551, see the instant compound UK-3A.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 14, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueki. (See Reference ).

Ueki et. al. teaches the compound, UK-3A. At page 551, see the instant compound UK-3A. The difference between the prior art compound and the instantly claimed compounds is the teaching of a positional isomer of the instant compound. Ueki discloses UK-3A which contains a 3-hydroxypicolinic acid ring which is a positional isomer of the R<sub>2</sub> variable which is the nicotinoyl group. It would have been obvious to one of ordinary skill in the art to make and use a positional isomer of the Ueki compound as position isomers are obvious in view of one another. Accordingly, instant the compounds are deemed obvious in the absence of a showing of unexpected results for the claimed compounds over those of the prior art compounds.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "R<sub>1</sub> represents a straight-chain or branched saturated aliphatic hydrocarbon group or unsaturated aliphatic hydrocarbon group" in lines 2-3, page 4. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1625

According to claim 1, R1 is a specific acyl group (i. e. isobutyryl, tigloyl, isovaleryl or 2-methylbutanoyl). The definition provided for R1 in the intermediate is broader than the definition of R1 in the final product.

Claim 23 recites the limitation "substituent" in lines 1-2, page6. There is insufficient antecedent basis for this limitation in the claim. The term "substituent" is broader than the actual substituents defined in claim 21.

Claims 23 recites the limitation "R2 is a picolinyl" in line 1, page 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 24-26 recite the limitation "R2 is a picolinyl group" in line 3, page 6. There is insufficient antecedent basis for this limitation in the claims.

Claims 20-21, 27 are objected to because they are based on a rejected claim. The closest prior art reference is Ueki et. al. (See Reference U). The difference between the Ueki compound and the instantly claimed compound is the R<sup>3</sup> moiety. In the instant compound, the R<sup>3</sup> group is a nitro group, amino, acylamino, or N, N-dialkylamino group. In the Ueki compound, the R<sup>3</sup> moiety is hydrogen. The instant compound is patentable over the prior art compound because the R<sup>3</sup> group is not hydrogen but must be nitro group, amino, acylamino, or N, N-dialkylamino group.

The prior art reference does not teach nor suggest to one of ordinary skill in the art how to modify the prior art compound to derive the instant compounds.

Claims 9-10 are allowable.

Art Unit: 1625

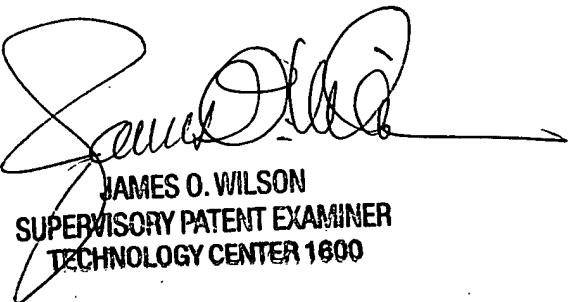
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

BMR  
July 11, 2005



JAMES O. WILSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600